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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,838	01/20/2004	LeVar M. Maxwell	4339P2742	4084

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EXAMINER

CAMPBELL, KELLY E

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,838

Applicant(s)

MAXWELL ET AL.

Examiner

Kelly E. Campbell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-20 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 8-10 and 12-13, 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Texidor (US 3,79,842).

Texidor teaches a retractable skate comprising, in combination: a sole (14) dimensioned to be coupled to a shoe (12), said sole defining at least one recess (24) therein; a first armature (16) having a first end and a second end and dimensioned to be retained in a stored position in said at least one recess of said sole, said first end of said first armature being pivotally coupled to said sole within said at least one recess, said second end of said first armature being dimensioned to extend out of said at least one recess when in use, see Figure 3;

a second armature (16a) having a first end and a second end and dimensioned to be retained in said at least one recess of said sole, said first end of said second armature being pivotally coupled to said sole within said at least one recess, said second end of said second armature being dimensioned to extend out of said at least one recess when in use; and at least one surface interface for providing travel on a surface and dimensioned to be coupled to said second end of said first armature and said second end of said second armature when said second end of said first armature

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and said second end of said second armature being extended out of said at least one recess;

a first fastener dimensioned to couple said at least one surface interface (22) to said second end of said first armature (16); and a second fastener dimensioned to couple said at least one surface interface (22a) to said second end of said second armature (16a);

further comprising means including at least one cover (31) coupled to said sole (14) and dimensioned to cover said at least one recess (17) for securing said first armature (16) and said second armature (16a) within said at least one recess; and at least one spring (26a) coupled to said sole proximate said at least one recess and at least one locking protrusion (silent) coupled to the spring via sole body (14), see Figure 4, extending from the recess in sole (14) and engaging the "stop" (20,20a) of armature (16,16a) coupled to said sole proximate said at least one recess and dimensioned to securely mate with at least one cavity of the "Stop" (20,20a) defined by each said first armature (16) and said second armature (16a).

With regards to claims 13,15-20, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in manipulative sense and not amount to the mere claiming of a use of a particular structure. Ex parte Pfeiffer, 1962 C.D. 408.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Yeh (US 6,386,556).

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Yeh teaches a retractable skate comprising, in combination: a sole (2) dimensioned to be coupled to a shoe, said sole defining at least one recess (21,21') therein; a first armature and second armature (3,3') having a first end and a second end and dimensioned to be retained in a stored position in said at least one recess of said sole, said first end of said first armature being pivotally coupled to said sole within said at least one recess, said second end of said first armature being dimensioned to extend out of said at least one recess when in use, see Figure 3;

a first fastener dimensioned to couple said at least one surface interface (32) to said second end of said first armature (3); and a second fastener dimensioned to couple said at least one surface interface (32') to said second end of said second armature (3);

wherein said first fastener and said second fastener each comprise a head, see Figure 1;

wherein said second end of said first armature (3) being forked and having a first tine and a second tine (31), see Figure 1, for accommodating said at least one surface interface (32) there between, said first tine and said second tine of said first armature each defining an aperture for accommodating said first fastener there through, said second end (31') of said second armature being forked and having a first tine and a second tine for accommodating said at least one surface interface (32') there between, said first tine and said second tine of said second armature each defining an aperture for accommodating said second fastener there through.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Texidor (US 3,979,842) as applied to claim 1 above, and further in view of Wu (US 6,065,759).

Texidor teaches all aspects of the invention as discussed above for claim 1, except the surface interface being a blade.

Wu teaches a skate having retractable armatures (9,10) and interchangeable, removable surface interfaces:

Wheels or blade of wheels (12) and see Figure 1(a) and/or an ice skating blade, see Figure 2 (a).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide interchangeable interfaces for traversing various surfaces, for providing a versatile economical skate useable on land or snow and preventing the user from needing multiple pairs of skates of various uses.

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Claims 3- 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeh (US 6,386,556) as applied to claim 2 above, and further in view of Chiang (US 6,402,162).

Yeh teaches all aspects of the claimed invention except the fasteners for attaching the surface interface specifically having a threaded end

Chiang teaches a retractable skate comprising, in combination: a sole (1) dimensioned to be coupled to a shoe, said sole defining at least one recess (11) therein; a first armature and second armature (22) having a first end and a second end and dimensioned to be retained in a stored position in said at least one recess of said sole, said first end of said first armature being pivotally coupled to said sole within said at least one recess, said second end of said first armature being dimensioned to extend out of said at least one recess when in use, see Figure 3;

a first fastener (231) dimensioned to couple said at least one surface interface (23) to said second end of said first armature (22); and a second fastener dimensioned to couple said at least one surface interface (23) to said second end of said second armature (22);

wherein said first fastener and said second fastener, being removable, each comprise a head and a threaded end, see Figure 1, each dimensioned to allow each of said first fastener and said second fastener to be rotated by hand, said threaded end of said first fastener dimensioned to be coupled to said second end of said first armature through an aperture, said threaded end of said second fastener dimensioned to be coupled to said second end of said second armature through an aperture.

With regards to the head of the first and second fasteners being threaded, so that said head of said first fastener and said head of said second fastener being positioned away from a skating surface when a skater leans into a left-hand turn, reversing the position of the fastener heads within the apertures would be obvious, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

With regards to the head of the fasteners having ridges, bolt head fasteners are well known in the art for attaching various mechanical structures and elements. The Examiner takes official notice to the selection of bolts offered in supply stores such as Home Depot or Lowes, including bolts with ridges on the heads for providing a firmer grip either by hand or for use with a wrench.

Allowable Subject Matter

Claim 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The primary reason for allowance being the additional limitations of a protrusion coupled to the sole proximate the recess defining at least one aperture of the first and second tine, for retaining the armature in the recess and retaining the first and second fasteners within the protrusion, wherein said first fastener being removable, said second

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fastener being removable, said sole defining at least one channel extending from a side of said sole to said at least one recess, said at least one channel dimensioned to receive at least one of said first fastener and said second fastener. A combination of these and other limitations have not been reasonable found within the prior art.

Conclusion

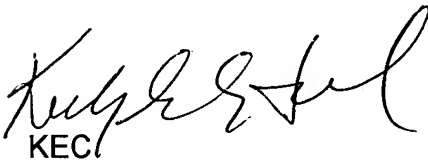
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schaefer teaches a convertible shoe having a protrusion engaging the wheels of the skate. Walle teaches a collapsible skate. Kao teaches a sneaker skate configuration and Chang teaches a convertible sneaker skate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly E. Campbell whose telephone number is (571) 272-6693. The examiner can normally be reached on 9:00-5:30 Monday-Friday.

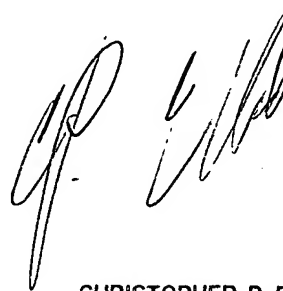
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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